

REMARKS

Claims 1-22 are pending in this application. Claim 23 is cancelled without prejudice or disclaimer. Claims 1, 5, 7, 17, and 19-22 are amended herein. Support for the amendments to the claims may be found in the claims as originally filed. No new matter has been added.

This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

Response to Arguments:

The Applicants request respectfully some consideration be given to their arguments filed October 26, 2005. The Applicants, in particular, are disappointed that their arguments were not found to be persuasive, and seek evidence and reasoning as to why. Further reconsideration is thus requested.

Objections to the Specification:

The Specification has been objected to for various informalities. Appropriate corrections were made. The word "fist" at line 25 of page 8 was replaced with word "first" in the amendment filed November 1, 2004, so that change was not performed again. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 112:

Claims 5 and 17 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The final Office Action asserts at page 2 that:

It is unclear how the command torques are altered in accordance with the type of material, shape or weight of the object.

A specification, however, need only enable a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. In particular, as provided in 35 U.S.C. § 112, first paragraph:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact

terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Thus, a specification need not provide a background tutorial to enable anyone to make and use the claimed invention, but rather persons skilled in the art. A person skilled in the art, furthermore, is presumed to already possess the necessary background information, that's why they're skilled in the art. In particular, as provided in M.P.E.P. § 2164.01:

A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The test of enablement is thus submitted to have been met by, *inter alia*, the description at page 7, lines 6-9 and at page 8, lines 9-12 of the specification:

It is determined whether or not the holding operation of the object W by the robot hand 11 is completed based on determination whether or not an output torque (driving current) of the servomotors for driving the fingers of the robot hand 11 reaches set values (Step S5).

Further, a desired holding force suitable for shape, material, hardness and weight of the object is obtained by setting command torques for obtaining the desired holding force to the controllers of the servomotors for driving the fingers of the robot hand 11.

Still, in the interest of compact prosecution, and not for any reason of patentability, claim 5 and 7 have been amended to recite, simply, "wherein command torques to the one or more servomotors for driving the fingers of said robot hand are altered." Claims 5 and 17 are thus submitted to meet the enablement requirement of 35 U.S.C. § 112, first paragraph. Withdrawal of the rejection is earnestly solicited.

35 U.S.C. § 112, second paragraph:

Claims 1-22 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1, 5, 7, 13, 17, and 19-22 were amended to make them more definite. In particular, every instance of the phrase "associated with" has been removed or replaced with the recitation "provided at."

With respect to claim 6, the controller and the compensating means perform, as least different functions. The "compensating means," for example, is recited in claim 1 as "automatically compensating for the position/orientation of the robot hand predetermined for

transferring the object to the second place based on the position/orientation of the object held by the robot hand relative to the robot hand detected by said second detecting means," while the "controller" of claim 6 is recited as "said one or more servomotors for driving the fingers of said robot hand are controlled by a controller of said robot." It is not clear, therefore, why they appear to be the same elements to the final Office Action. It is submitted, rather, that their separate nature is clear from the associated recitation. If further discussion would help clear this up, a telephone call to the undersigned representative of the Applicants is earnestly solicited.

With respect to the statement at page 3 of the final Office Action to the effect that the "Applicants should identify which structure in their invention comprises each of the means and devices," the Applicants request respectfully some showing as to where in 35 U.S.C. § 112 this requirement may be found. It is submitted, rather, that reciting structure in so called means-plus-function claims may actually render them *indefinite*. 35 U.S.C. § 112, sixth paragraph, in particular, which governs means-plus-function claims, provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Since 35 U.S.C. § 112, sixth paragraph, prohibits the recital of structure in support of a means for performing a specified function, claim 7 is submitted to be definite within the meaning of 35 U.S.C. § 112, second paragraph.

The statement at page 3 of the final Office Action to the effect that the word "or" renders a claim indefinite is submitted to be incorrect. As provided for at M.P.E.P. § 2173.05(h)(II), rather, "or" terminology is acceptable. In particular:

Alternative expressions using "or" are acceptable, such as "wherein R is A, B, C, or D." The following phrases were each held to be acceptable and not in violation of 35 U.S.C. 112, second paragraph in *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975): "made entirely or in part of"; "at least one piece"; and "iron, steel or any other magnetic material."

Since alternative expressions using "or" are acceptable, claim 1-22 are thus submitted to meet the requirements of 35 U.S.C. § 112, second paragraph. Withdrawal of the rejections is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-22 are allowable over the cited references. Allowance of all claims 1-22 and of this entire application is therefore respectfully requested.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

By:

Thomas E. McKiernan
Registration No. 37,889

Date: 09/1/06

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501